



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/590,742

05/07/2007

Robert William Albert Dobson

MC1-8324

1229

26294

7590

04/14/2010

TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P.  
1300 EAST NINTH STREET, SUITE 1700  
CLEVELAND, OH 44114

EXAMINER

LEE, ANDREW CHUNG CHEUNG

ART UNIT

PAPER NUMBER

2476

MAIL DATE

DELIVERY MODE

04/14/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1 – 41 have been canceled by Preliminary Amendment dated 11/13/2007.
2. Claim 62 has been canceled by amendment dated 01/14/2010.
3. Claims 42 – 61, 63 – 81 are pending.

### ***Claim Objections***

4. Claims 42 – 53, 70, 72, 74 - 76, 79, 80 are objected to because of the following informalities:

Regarding claims 42 – 53, the amended claim subject matter “A computer implemented method” is improper. “A computer implemented method” implies a computer program claim, but not a method as original claim. Hence the scope of the claim has been changed completely. Clarification and appropriate correction are required. The term “computer implemented” should be deleted.

Regarding claims 70, 72, 74 - 76, 79, 80, the claims have the same discrepancies as addressed above in claims 42 – 53.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 54, 71, 73, 77, 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Regarding claims 54, 71, 73, 77, 81, the claims are addressing for the first time the validity of a single claim covering both an apparatus and a method of using that apparatus, the U.S. Court of Appeals for the Federal Circuit followed *Ex parte Lyell*, a Board of Patent Appeals and Interferences (Board) case, which held such claims invalid. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, Case Nos. 05-0119, -1487 (Fed. Cir. Nov. 21, 2005) (Clevenger, J.).

IPXL alleged that Amazon's "1-click system" infringed certain claims of its patent. The district court held that one of the asserted claims, which claimed both an apparatus and its method of use, was invalid due to indefiniteness. IPXL appealed, and the Federal Circuit affirmed.

The claim in issue was directed to an ATM system and to a method for using it. The Federal Circuit held the claim invalid under s. 112 [paragraph] 2 because it did not "apprise a person of ordinary skill in the art of its scope." The Court focused on the fact that the combination of the two statutory classes of invention rendered a manufacturer or seller of the claimed apparatus unable to determine, based on the claim, whether it could be found liable for contributory infringement if a buyer or user of the apparatus were to carry out the claimed method of using the apparatus.

The Court cited MPEP s. 2173.05(p) (II) (1999), a section that follows the Board's *Ex parte Lyell* decision. The cited MPEP section states that where a single claim claims both an apparatus and the method of using that apparatus, it is indefinite under s. 112.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 66, 64, 65, 66, **67**, 68, 69, 54, 71, 73, 77, 78, 81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 66, 64, 65, 66, **67**, 68, 69, 54, 71, 73, 77, 78, 81, the claims are merely a program claim, per se. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

***Allowable Subject Matter***

8. Claims 55 – 61 are allowed.
9. The following is an examiner’s statement of reasons for allowance:

The prior art made of record, in single or in combination, fails to disclose explicitly the limitations of:

“wherein said at least one first listener is configured to read input data from said data pipe and to write first listener output data determined from said input data back to said data pipe, wherein at least some of said first listener output data is not valid until after a delay greater than a time sufficient to write data successively into said data pipe;

wherein said at least one second listener is configured to read second listener input data including said first listener output data from said data pipe, and to provide output data determined from said read second listener input data; and wherein a start of said second region of said data pipe is earlier than a start of said first region of said data pipe by at least said delay.” as disclosed in claim 55.

10. Additionally, all of the further limitations in claims 56 – 61 are allowable since the claims are dependent upon independent claim.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

### ***Response to Arguments***

12. Applicant’s arguments, see page 20, filed on 01/14/2010, with respect to the claims 55 - 61 have been fully considered and are persuasive. The rejection of claims 55 - 61 has been withdrawn.

The objection and rejection to the claims 42 – 61, 63 – 81 might be considered to be withdrawn if and only if all the objections and rejections under 112 and 101 are overcome.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Lee whose telephone number is (571)272-3131. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2476

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew C Lee/  
Examiner, Art Unit 2476 <3Q10::4\_10\_10>

/Ayaz R. Sheikh/  
Supervisory Patent Examiner, Art  
Unit 2476